REMARKS/ARGUMENTS

Claims 16 to 22 and 25 to 33 have been undergoing examination with claims 1 to 15 and 34 to 36 standing withdrawn. Claims 1 to 15 are herein canceled without prejudice. Claims 37 to 46 are newly presented. Claims 18 and 35 are amended. After entry of these amendments, claims 16 to 22 and 25 to 33 will be undergoing examination with claims 34 to 46 standing withdrawn.

Claim 19 stands objected to as allegedly not further limiting the subject matter of the claim from which it depends.

Claims 16-22, 25-31, 33 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over de Fonseca, et al. ("An anorexic lipid mediator regulated by feeding"; 2001 Nov; Nature; 414:209-212) and Di Marzo, et al. ("Leptin-regulated endocannabinoids are involved in maintaining food intake"; 2001 Apr; Nature; 41 0: 822-825).

Support for the amendments to the claims.

Claim 18 was amended to conform a portion of its generic structure (i.e., -C(O)NH-NR_2R_3) with the structure of the ensuing dependent claim 19 and finds its support accordingly. The subject matter wherein R_1 is other than H also finds support in U.S. Patent No. 6,028,084 (already of record) which was incorporated by reference in its entirety and particularly with respect to the compounds disclosed therein by virtue of paragraph 242. Support can most easily be ascertained from the granted base claim of the '084 patent. Support for the recital of R_1 is H is further found in original dependent claim 19.

Claim 35 was amended to set forth that the appetite for a food, ethanol, or a psychoactive substance is reduced. This recital finds support in the previous version of the claim and in the Abstract.

New claims 37 to 45 find support in original claim 11 in view, respectively, of original claims 1 to 8.

New claim 45 finds support as set forth above with respect to amended claim 18.

Accordingly, the Applicants respectfully submit that the amendment to the claims add no new matter and respectfully request their entry.

Response to the objection to claim 19.

The Applicants have amended claim 18 to cure the concern and respectfully request reconsideration and withdrawal of this grounds of rejection.

The Specification

Paragraph 241 of the specification was amended to delete reference to the compound name whilst retaining the formula for the compound recited therein. The deletion avoids the need to correct a typographical error in the recited name (SR 141616 should have been set forth as SR 141716).

Paragraph 242 of the specification was amended to set forth the compound subject matter of claim 18 as amended and finds support as described above.

Accordingly, the Applicants believe the amendments to the specification add no new matter and respectfully request their entry.

Response to the rejection of claims 16-22, 25-31, 33 under 35 U.S.C. 103(a) as allegedly being unpatentable over de Fonseca, et al. and Di Marzo, et al.

Rebuttal of the *prima facie* case.

Assuming *arguendo* that a *prima facie* case of non-obviousness existed, Applicants note that pursuant to MPEP § 716.02(a) a *prima facie* case can be rebutted by a showing of

> "A greater than expected result is an evidentiary factor pertinent to the legal conclusion of obviousness ... of the claims at issue." *In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985). In *Corkhill*, the claimed combination showed an additive result when a diminished result would have been expected. This result was persuasive of nonobviousness even though the result was equal to that of one component alone. Evidence of a greater than expected result may also be shown by demonstrating an effect which is greater than the sum of each of the effects taken separately (i.e., demonstrating "synergism"). *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), *cert. denied*, 493 U.S. 975 (1989).

(see MPEP, Rev. 6, Sept. 2007 at p. 700-292). Next, the Applicants respectfully call the Examiner's attention to Figure 21 of the specification (reproduced below for the convenience of the Examiner):

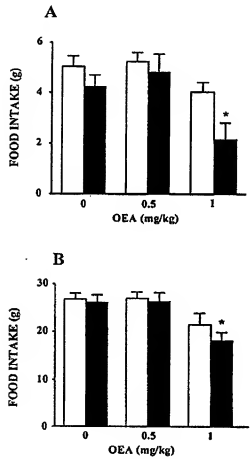

FIGURE 21

At paragraph 74, the specification describes the above figure thusly:

> Figure 21. Synergistic effects of SR141716A and OEA on feeding suppression. Effects of subthreshold doses of SR141716A (0.3 mg/kg i.p,) and OEA (0.5 and 1 mg/kg i.p.) on food intake in 24 hr food.-deprived rats, A. 2 h after injection of OEA and B. 24 h. after injection of OEA. Either vehicle (open bars) or

SR141716A (black bars) were injected 30 min prior to OEA. Data are the means ± SEM of at least 10 determinations per group. (*) P < 0.01, versus vehicle-treated group, Newman-Keuls.

The above figure demonstrates the synergism which exists in the claimed inventive compositions. Figure 21 shows that when a PPARα agonist and a CB1 antagonist are each used at a concentration which has **no** significant effect on food intake by itself, the administration of the combination resulted in a **large** reduction in food intake. This demonstrated synergism of the components is of practical value. As set forth in paragraph 287 of the specification, the synergy between the PPARα agonist and the CB1-cannabinoid antagonist make it possible to eliminate or control or reduce the side effects associated with the use of these compounds to reduce appetite.

Accordingly, the applicants respectfully request that the above grounds for rejection be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

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